REMARKS

Applicant submits this Amendment in response to the Office Action mailed on February 25, 2008. Claims 1, 6, 7, 15, 37, 42, 43, 53, 75, 80, 81, and 89 are hereby amended. Claims 1-17, 37-55, and 75-91 are presented for further consideration, with claims 18-35, 56-73, and 92-108 having been withdrawn from consideration and claims 36, 74, and 109 having been canceled.

I. Examiner Interview

Applicant thanks the Examiner for discussing the application with Applicant's representative during a telephone interview on March 31, 2008. During the interview, Applicant's representative and the Examiner discussed proposed amendments to overcome the rejections under 35 U.S.C. § 102(e) discussed in the Office Action of February 25, 2008. Applicant's representative further indicated to the Examiner that the 35 U.S.C. 103(a) rejections are improper because pursuant to 35 U.S.C. § 103(c), the Lilly reference does not qualify as prior art for the purposes of Section 103(a).

II. Information Disclosure Statement

Applicant hereby submits the attached Information Disclosure Statement, citing all prior art cited to date during prosecution of U.S. Patent Application No. 09/780,468 (published as U.S. Patent Application Publication No. 2002/0156723), to Lilly et al. ("Lilly"). Lilly was cited as prior art in the Office Action of February 25, 2008, and is assigned to the same Assignee as the present application.

III. Rejections Under 35 U.S.C. § 103(a)

The Examiner has improperly rejected claims 15, 16, 53, 54, 89, and 90 under 35 U.S.C. § 103(a). As stated in Applicant's response of November 28, 2007, Section 103

requires that "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. § 103(c)(1).

Both Lilly and the present application have been assigned to Capital One Financial Corporation and were subject to an obligation of assignment to Capital One Financial Corporation at the time the inventions were made, with Lilly having a recordation date of April 12, 2001, and a Reel/Frame number of 011721/0006, and the present application having a recordation date of December 6, 2006, and a Reel/Frame number of 018666/0347.

Thus, Lilly does not qualify as prior art for the purposes of 35 U.S.C. § 103(a). As such, the rejection of claims 15, 16, 53, 54, 89, and 90 under 35 U.S.C. § 103(a) in view of Lilly and Erlich is improper, and should be withdrawn.

IV. Rejections Under 35 U.S.C. § 102(e)

In the final Office Action, the Examiner rejected claims 1-14, 17, 37-52, 55, 75-88, and 91 under 35 U.S.C. § 102(e) as allegedly being anticipated by Lilly. Applicant traverses these rejections for at least the reasons below.

Claim 1 has been amended to recite a method for providing messages, comprising, *inter alia*, the following:

> "determining whether the sum of the cost of the item and the outstanding balance exceeds the financial account limit; and
>
> prior to the item being purchased, presenting a message for display along with the web page based on a determination that the sum of the cost of the item and the outstanding balance does not exceed the financial

account limit, wherein the message includes an indication reflecting a new outstanding balance that will be associated with the financial account after the user purchases the item from the web site using the financial account."

In order to support a rejection under 35 U.S.C. § 102(e), each and every element as set forth in the claims must be described, either expressly or inherently, in a single prior art reference. M.P.E.P. § 2131. Lilly, however, fails to teach each and every recitation of claim 1.

Lilly discloses a method and system for providing extra lines of credit to customers. In certain embodiments, the lines of credit may be offered to a customer at a point of sale terminal or website, and may be offered in response to a customer's purchase. *See, e.g.*, paragraphs 78-82. Further, in certain embodiments, an extra credit line may then be used in a transaction by a customer. *See, e.g.*, paragraph 89. Also, in certain aspects, a central database may store credit information for each customer account, including customer credit limits. *See, e.g.,* paragraph 49.

In other embodiments Lilly further authorizes transactions, such that "[o]nce analysis of the customer's account is complete, and card issuer 422 determines that the purchase amount does not exceed the available balance for the customer's extra credit line, the transaction is authorized." Paragraph 89. As such, Lilly does not disclose "prior to the item being purchased, presenting a message for display . . . based on a determination that the sum of the cost of the item and the outstanding balance does not exceed the financial account limit," where, *inter alia*, "the message includes an indication reflecting a new outstanding balance that will be associated with the financial account after the user purchases the item from the web site using the financial account,"

as recited in claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. § 102(e) should be withdrawn.

Claims 37 and 75, though of different scope from claim 1, also recite "prior to the item being purchased, presenting a message for display . . . based on a determination that the sum of the cost of the item and the outstanding balance does not exceed the financial account limit," wherein "the message includes an indication reflecting a new outstanding balance that will be associated with the financial account after the user purchases the item from the web site using the financial account." Therefore, the cited art fails to teach or suggest the recitations of claims 37 and 57 for at least the same reasons discussed above in connection with claim 1. Accordingly, the rejection of claims 37 and 75 should be withdrawn as well.

Claims 2-14, 17, 38-53, 76-88, and 91 depend from one of claims 1, 37, and 75, and are thus distinguishable over Lilly for at least the same reasons discussed above in connection with claims 1, 37, and 75. In addition, the dependent claims include additional recitations that are not disclosed by Lilly.

For example, Lilly fails to disclose "ranking the financial account based on a current status of the account," and "presenting a message reflecting that the financial account limit will be exceeded, based on a determination that the sum of the cost of the item and the outstanding balance exceeds the financial account limit and based on the rank of the financial account," as recited in claims 5, 41, and 79. The Examiner asserts that paragraphs 41 and 49-50 of Lilly disclose these recitations, because they allegedly disclose "targeting specific customers based on level of risk." Office Action at 4-5. Nonetheless, regardless of the accuracy of this assertion, "targeting specific customers

based on level of risk" does not disclose "ranking the financial account based on a current status of the account," and "presenting a message reflecting that the financial account limit will be exceeded, based on a determination that the sum of the cost of the item and the outstanding balance exceeds the financial account limit and based on the rank of the financial account," as recited in claims 5, 41, and 79. Neither paragraphs 41 and 49-50, nor any other portion of Lilly disclose these recitations as claimed.

Lilly further fails to disclose that the message "further includes an indication reflecting a number of payments at a determined amount that, if the item is purchased with the financial account, the user would have to make to a financial account issuer," as recited in claims 12, 50, and 86. The Examiner asserts that paragraph 115 discloses this recitation. Office Action at 6. Applicant respectfully disagrees. Although paragraph 115 of Lilly discloses an offer for an extra line of credit, neither this portion, nor any other portion of Lilly disclose a message that "further includes an indication reflecting a number of payments at a determined amount that, if the item is purchased with the financial account, the user would have to make to a financial account issuer," as recited in claims 12, 50, and 86.

Lilly additionally fails to disclose that the message "further includes an indication reflecting a payment amount that the user would periodically have to make to a financial account issuer to pay off the purchase price of the item," as recited in claims 14, 52, and 88. The Examiner asserts that paragraph 126 of Lilly discloses this recitation. Office Action at 6. Applicant respectfully disagrees. Although this portion of Lilly discloses, *inter alia*, that "the exact manner by which a credit card issuer will apply payments will be indicated to a customer in a credit card agreement offered to the customer," and

further discloses "[p]roportional payments allow credit card issuer to divide a payment into sub-payments for application to the credit lines with outstanding balances," neither this portion of Lilly, nor any other portion discloses a message that "further includes an indication reflecting a payment amount that the user would periodically have to make to a financial account issuer to pay off the purchase price of the item," as recited in claims 14, 52, and 88.

For at least these additional reasons, the rejection of claims 5, 12, 14, 41, 50, 52, 79, 86, and 88 under 35 U.S.C. § 102(e) should be withdrawn.

V. Response to Examiner's Comments Regarding the Term "If"

The Examiner asserts that with regard to claims 6, 7, 12, 13, 15, 42, 43, 50, 51, 53, 80, and 81, "the recited 'if' . . . phrases are conditional limitations with the noted 'if' statement not necessarily performed." Applicant has amended claims 6, 7, 15, 42, 43, 53, 80, and 81 in response to the Examiner's comments, to recite "determining . . . and in response to the determining, presenting." The remaining uses of the term "if" in these claims are recited in the context of an "indication," and do not include "conditional limitations with the noted 'if' statement not necessarily performed." For example, claim 6 recites "a message reflecting an indication that if the item is purchased using the financial account, the financial account limit will be exceeded." As such, these claim recitations should be given full patentable weight.

CONCLUSION

In view of the foregoing remarks, Applicant requests reconsideration of this application, and timely allowance of pending claims 1-17, 37-55, and 75-91.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

If a telephone interview will expedite issuance of this Application, the Examiner is requested to call Applicant's representative whose name and registration number appear below, at 202-408-4138, to discuss any remaining issues.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 2, 2008

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